

Appl. No. 10/585,612  
Amendment dated October 30, 2009  
Reply to Office Action of August 5, 2009

## **REMARKS**

In the August 5, 2009 Office Action, all of the claims stand rejected in view of prior art. No other objections or rejections were made in the Office Action.

### ***Status of Claims and Amendments***

In response to the August 5, 2009 Office Action, Applicant has amended the specification, abstract and claims 1-14 as indicated above. Thus, claims 1-14 are pending, with claim 1 being the only independent claim. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

### ***Specification***

A substitute specification in accordance with 37 CFR 1.125(b) is attached with this Amendment. Also a marked-up version of the substitute specification is attached showing the changes between the original specification and the substitute specification. In accordance with 37 CFR 1.125(b), Applicant states that the substitute specification includes no new matter. Basically, Applicant has amended the specification to correct minor informalities and to more closely correspond to common U.S. format.

### ***Abstract***

Applicant has amended the Abstract to correct minor informalities and to more closely correspond to common U.S. format.

### ***Rejections - 35 U.S.C. § 102***

In paragraph 4 of the Office Action, claims 1, 5 and 9 stand rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent Publication No. 07-274938 (Takamoto). In response, Applicant has amended independent claim 1 to more clearly define the present invention over the prior art of record.

In particular, independent claim 1 now requires a plurality of cassettes holding microorganisms or cells; and a heater and a cooling unit making control of temperatures inside said cassettes, said control is corrected by using an ambient temperature that is a

temperature of an environment in which said temperature control device itself is installed.

Clearly, this structure is *not* disclosed or suggested by the Takamoto publication. This amendment is supported by at least page 2, lines 5-6 of the instant application.

Specifically, the Takamoto publication indicates in [0015] that based on the difference between a temperature measured by a temperature sensor and a target value of a set temperature, the temperature is controlled to reach the target value immediately. At this time, as indicates in [0013] of the Takamoto publication, a temperature in a well is not directly measured by the temperature sensor. However, from descriptions of “a temperature environment of a sample in a well is controllable swiftly and accurately” in [0022] and “compare the target value (a set temperature value) with the incorporated measured value, and evaluate a control amount which is proportional to the difference (a control deviation),... control so as to reach the set temperature immediately...” in [0015] of the Takamoto publication, it appears that a temperature measured by the temperature sensor corresponds to a temperature in a well, not an ambient temperature as now more clearly set forth in independent claim 1.

More specifically, the arrangement now set forth in independent claim 1 of the present application performs corrections on control of a temperature of a cell based on an ambient temperature that is a temperature of an environment in which a temperature control device is installed. On the other hand, the Takamoto publication indicates to incorporate a temperature corresponding to a temperature in a cell by the temperature sensor and perform control of the temperature in the cell. However, the Takamoto publication never refers to performing control corrections on control as well as to consider the ambient temperature of the environment in which the temperature control device is installed, as now recited in independent claim 1. Therefore, the Takamoto publication does not include all of the features of independent claim 1 as now amended.

It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference. Therefore, Applicant respectfully submits that claim 1, as now amended, is not anticipated by the Takamoto publication. Accordingly, withdrawal of this rejection of independent claim 1 is respectfully requested.

Moreover, Applicant believes that dependent claims 5 and 9 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, dependent claims 5 and 9 are further allowable because they include additional limitations, which in combination with the limitations of independent claim 1, are not disclosed or suggested by the Takamoto publication. Accordingly, Applicant also respectfully requests withdrawal of this rejection of dependent claims 5 and 9.

***Rejections - 35 U.S.C. § 103***

In paragraphs 7-9 (pages 4-12) of the Office Action, claims 2-4, 6-8 and 10-14 stand rejected under 35 U.S.C. §103(a) as follows:

- (1) Claims 2, 3, 6, 7, 10 and 11 are rejected as being unpatentable over the Takamoto publication in view of U.S. Patent No. 5,802,856 (Schaper);
- (2) Claims 4, 8, 12 and 13 are rejected as being unpatentable over the Takamoto publication in view of the Schaper patent and further in view of U.S. Patent No. 6,626,236 (Bandoh); and
- (3) Claim 14 is rejected as being unpatentable over
  - (a) the Takamoto publication as applied to claims 1, 5 and 9, in view of Japanese Patent Publication No. 2003-235544 (Haga),
  - (b) the Takamoto publication in view of the Schaper patent as applied to claims 2, 3, 6, 7, 10 and 11, in view of Japanese Patent Publication No. 2003-235544 (Haga), and
  - (c) the Takamoto publication in view of the Schaper and Bandoh patents as applied to claims 4, 8, 12 and 13, and further in view of the Haga publication.

In response, Applicant has amended independent claim 1 to more clearly define the present invention over the prior art of record as mentioned above.

In particular, independent claim 1 now requires a plurality of cassettes holding microorganisms or cells; and a heater and a cooling unit making control of temperatures inside said cassettes, said control is corrected by using an ambient temperature that is a temperature of an environment in which said temperature control device itself is installed. Clearly, this structure is **not** disclosed or suggested by the Takamoto publication, the Schaper patent, the Bandoh patent and/or the Haga publication, singularly or in combination.

Specifically, the Takamoto publication fails to disclose or suggest the features of independent claim 1, as now amended, as explained above. The remaining references fail to account for the deficiencies of the Takamoto publication with respect to independent claim 1. More specifically, the remaining references relied upon in rejections (1) to (3), the Schaper patent, the Bandoh patent and the Haga publication, do not disclose or suggest an arrangement where control is corrected by using an ambient temperature that is a temperature of an environment in which said temperature control device itself is installed, as now required by independent claim 1. Since none of the references used in these rejections discloses this unique arrangement, any hypothetical device created by somehow combining these references cannot include this unique arrangement of independent claim 1, as now amended. Therefore, no combination of the references relied upon in rejections (1) to (3) can disclose or suggest the arrangements of dependent claims 2-4, 6-8 and 10-14, which depend from independent claim 1. Accordingly, withdrawal of rejections (1) to (3) of this section is respectfully requested.

Under U.S. patent law, the mere fact that the prior art can be modified does **not** make the modification obvious, unless an *apparent reason* exists based on evidence in the record or scientific reasoning for one of ordinary skill in the art to make the modification. See, KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007). The KSR Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some “apparent reason to combine the known elements in the fashion claimed.” Id. at 1741. The current record lacks any apparent reason, suggestion or expectation of success for combining the patents, and then further modifying a hypothetical device created by such a hypothetical combination, to create Applicant’s unique arrangement of independent claim 1, as now amended.

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In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-14 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested. If there are any questions regarding this Amendment, please feel free to contact the undersigned.

Respectfully submitted,

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